

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. TYGAR,
STANLEY E. CHRAPOWICKI and ERIC S. BLASIC

Appeal No. 2001-2639
Application No. 09/386,753

HEARD: JANUARY 15, 2002

Before COHEN, FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-8. Claim 9, the only other claim pending in this application, stands objected to as being dependent upon a rejected claim.

BACKGROUND

The appellants' invention relates to a golf ball launching device. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Lake	884,024	Apr. 7, 1908
Junkin	2,634,717	Apr. 14, 1953
Bullock	3,288,127	Nov. 29, 1966
Slonaker et al. (Slonaker)	5,640,945	Jun. 24, 1997

The following are the only rejections before us for review.

(1) Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lake.

(2) Claims 1 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slonaker in view of Bullock.

(3) Claims 2-6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slonaker in view of Bullock and Junkin.

Other rejections set forth in the final rejection and not repeated in the answer are presumed to have been withdrawn.

See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957). Although

the examiner neglected to designate them as such, rejection (2), as applied to claim 7, and rejection (3) are, in fact, new grounds of rejection which are expressly prohibited in an examiner's answer by 37 CFR § 1.193(a)(2). Nevertheless, as appellants have not objected to the entry of new grounds of rejection in the answer by petition under 37 CFR § 1.181¹ and have presented arguments against the new grounds of rejection in the reply brief, we shall decide the appeal of the rejections set forth in the answer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 11 and 13) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

¹ See Manual of Patent Examining Procedure (MPEP) § 1208.01.

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1 recites, *inter alia*, "support means mounted in said bore between said pneumatic means and said cover to dispose a center of a ball on said axis." Likewise, claim 7, the only other independent claim on appeal, recites, *inter alia*, "support means in said bore of said barrel upstream of said lateral opening for mounting the golf ball coaxially within said bore of said barrel...".

The sixth paragraph of 35 U.S.C. § 112 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Consistent with the sixth paragraph of 35 U.S.C. § 112, we look to appellants' specification to determine the structure described therein (and equivalents thereof) which corresponds to the "support means ..." recited in claims 1 and 7. We are informed by appellants' specification that

[t]he support means may be in the form of an elastomeric annular ring, a plurality of circumferentially spaced apart pins, elastic fingers, ramps, or the like, any one of which is characterized in centering a ball on the centerline of the bore and holding the ball in place [page 2].

Thus, we conclude that the "support means ..." recited in claims 1 and 7 requires structure in the bore of the barrel which radially supports and centers the ball on the centerline (central longitudinal axis) of the bore and holds the ball in place.

Rejection (1)

In relying on Lake to reject claim 1 under 35 U.S.C. § 103, the examiner identifies the cup *v* and stud *w* (Figure 2) as the structure which responds to the "support means" of claim 1. Like appellants, we recognize that the cup and stud are incapable of supporting and centering the ball without the strap *r*. From our perspective, the structure (the cup, stud and strap of Figures 1-4 or the strap in Figure 5) which performs the supporting function cannot reasonably be considered to be between the compressed air source *P* and associated tubing and the breech closure *S* which respond

respectively to the "pneumatic means" and "cover" of claim 1. It follows that Lake's machine does not satisfy the requirement in claim 1 that the support means be "between said pneumatic means and said cover."

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In this instance, the examiner has proffered no evidence to support the assertion that "it would have been obvious to one skilled in the art at the time of the invention to have placed the support any distance in the bore from the cover" (answer, page 3) and we find in Lake no suggestion for one skilled in the art to have relocated the support (strap *r*, etc.) to a location between the compressed air source and the breech closure. In fact, to relocate the strap *r*, and hence the

ball, upstream of the compressed air source would appear to render Lake's machine inoperative, as the burst of compressed air would not push the ball out of the barrel.

For the foregoing reasons, we conclude that Lake would not have suggested the subject matter of claim 1. Accordingly, we shall not sustain rejection (1).

Rejections (2) and (3)

Slonaker is the jumping off point for the examiner's obviousness determinations in rejections (2) and (3). Having carefully reviewed the disclosure of Slonaker, we can find therein no structure which radially supports and centers the ball on the centerline (central longitudinal axis) of the bore and holds the ball in place so as to respond to the "support means" recited in claims 1 and 7. From Slonaker's description of the bolt 40 (column 5, line 65 *et seq.*), the bolt 40 appears to merely serve an axial pushing function to move the paintball into firing position and does not provide any radial support to center the paintball on the centerline of the bore.

We have reviewed the teachings of Bullock and Junkin and find therein no teaching or suggestion to provide structure in

the Slonaker paintball gun which radially supports the paintball to center it on the centerline of the bore of the barrel so as to satisfy the "support means" recitation of claims 1 and 7. Accordingly, we shall not sustain the examiner's rejection of claims 1 and 7 as being unpatentable over Slonaker in view of Bullock or claims 2-6 and 8, which depend from claims 1 and 7, as being unpatentable over Slonaker in view of Bullock and Junkin.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1-8 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
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